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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/592,596

06/12/2000

Richard Humpleman

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11/02/2006

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EXAMINER

TRAN, MYLINH T

ART UNIT

PAPER NUMBER

2179

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/592,596

Applicant(s)

HUMPLEMAN ET AL.

Examiner

Mylinh Tran

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection.. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/23/06 has been entered.

### **Terminal Disclaimer**

The examiner notes Applicant's submission of Terminal Disclaimer filed 06/10/2005 to overcome provisional obviousness-type double patenting rejection. However, the examiner maintains the current double patenting rejection at the present time, pending an official decision by the Office Paralegal regarding acceptance of said disclaimer.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 91 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ

619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely fled terminal disclaimer in compliance with 37 CFR 1.321 (c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 6, 7, 9, 10, 11, 16, 17, 19, 20, 21, 23, 24, 26 and 27 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, and 11-13 of copending Application No. 09/592598 in view of Saito et al ("Saito", US 6,523,696).

This is a provisional obviousness-type double patenting rejection.

As per claim 1, 11 and 21, claim 1 of 09/592598 claims the same subject matter as claims 1, 11 and 21 of 09/592596 except that first devices, capable of displaying a user interface, are connected to a first network and second devices are connected to a second network. Claim 1 of 09/592598 only discloses all the devices are connected to one single network. However, Saito teaches obtaining

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information from said first devices currently connected to the first network (1<sup>st</sup> and 2<sup>nd</sup> Home Network 203 of fig. 7), and obtaining information from the interface device (PC 210 of fig. 7) about the second devices connected to the second network (*Home Automation Network* 212 of fig. 7; col. 21, lines 50-60). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teaching from Saito of having first display capable devices and second devices connected to the first and second network, respectively, in claim 1 of 09/592598 since it would have allowed devices to be controlled over different networks.

As per claims 6, 16 and 23, claim 6 of 09/592598 claims the same subject matter as claims 6, 16 and 23 of 09/592596.

As per claims 7, 17 and 24, claim 12 of 09/592598 claims the same subject matter as claims 7, 17 and 24 of 09/592596.

As per claims 9, 19 and 26, claim 11 of 09/592598 claims the same subject matter as claims 9, 19 and 26 of 09/592596.

As per claims 10, 20 and 27, claim 13 of 09/592598 claims the same subject matter as claims 10, 20 and 27 of 09/592596.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al. [US 6, 523, 696] in view of Yang [US. 6,133,847].

As per independent claim 1, Saito teaches a computer implemented method and corresponding system for providing user interfaces in a first network including first devices interconnected via a communication medium and at least one interface device connecting said first network to at least a second network having interconnected second devices, the user interfaces for controlling the devices that are currently connected to the first network and devices that are currently connected to the second network, comprising the steps/means: obtaining information from said first devices currently connected to the first network (1" and 2"d *Home Network 203* of fig. 7), said information including graphical and/or textual information (col. 21, lines 5-10); obtaining information from the interface device (PC 210 of fig. 7) about the second devices connected to the second network, said information including graphical and/or textual information; and (*Home Automation Network 212* of fig. 7; col. 21, lines 50-60);

Saito fails to clearly teach the step of generating the user interface and displaying a control user interface.

However, Yang teaches generating a user interface description in one or more of said first devices based at least on the obtained information, the user interface description in each first device including: at least one graphical and/or textual reference of said first devices that are currently connected to the first network, and at least one graphical and/or textual reference of said second devices that are currently connected to the second network (column 4, lines 15-38); and displaying a top level user interface based on the user interface description on a device connected to the first network capable of displaying user interfaces (column 4, lines 30-58); displaying a control user interface on a device connected to the first network capable of displaying user interfaces (column 5, lines 32-46) for user control one or more of said first and second devices by: using a reference in a user interface description, the reference corresponding to a first device or a second device, to perform the steps of: using said reference to access the associated information stored in said corresponding device; generating the control user interface including device data corresponding to said corresponding device using the accessed information stored in said corresponding device; and displaying the control user interface for user control of said corresponding device (column 5, line 33 through column 6, line 58).

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It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine Yang's teaching with the system of Saito. Motivation of the combination would have to be available controls for user selected.

As per claim 2, which is dependent on claim 1, Yang teaches said interface device includes information about the second devices (column 4, lines 15-38). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine Yang's teaching with the system of Saito. Motivation of the combination would have to be available controls for user selected.

As per claim 3, which is dependent on claim 1, Saito teaches the first network comprises a 1394 bus (1<sup>st</sup> and 2<sup>nd</sup> *Home Network* of fig. 7), and the second network comprises a non-1394 bus (*Home Automation Network* of fig. 7).

As per claim 4, which is dependent on claim 3, Saito teaches the interface device includes an address extension table for the second devices, and wherein step of obtaining information from the interface device further includes the steps of using the address extension table to access said second devices (col. 24, lines 41-67 through col. 25, lines 1-3).

As per claim 5, which is dependent on claim 1, it is inherent in Saito's system that the PC device 210 (fig. 178) would include a bridge device acted as an interface between the 2<sup>nd</sup> Home Network and Home Automation Network.



As per claim 6, which is dependent on claim 1, Yang teaches displaying one or more top level user interfaces each based on a user interface description, on one or more devices connected to the first network capable of displaying a user interface, for user control of said first and second devices (column 6, lines 7-47). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine Yang's teaching with the system of Saito. Motivation of the combination would have to be available controls for user selected.

As per claim 7, which is dependent on claim 6, Yang teaches the step of displaying each user interface further includes the steps of: using each reference in the corresponding user interface description to access the associated information in each device; generating the top level user interface including device data corresponding to each device using the accessed information in each device; and displaying the top level user interface on said device capable of displaying a user interface (column 6, lines 7-47). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine Yang's teaching with the system of Saito. Motivation of the combination would have to be available controls for user selected.

As per claim 8, which is dependent on claim 1, Yang teaches the step of generating a user interface description further comprises the steps of:

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associating a hyper-text link with the device information of one or more of said first and second devices (column 4, lines 15-55).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine Yang's teaching with the system of Saito.

Motivation of the combination would have to be available controls for user selected.

As per claims 9 and 10, which are dependent on claims 1 and 9 respectively, Yang teaches the information in each device includes a user control interface description for user interaction with the device and the step of generating a user interface description further includes the steps of generating each user interface description such that each reference in that user interface description is to at least the user control interface description in each corresponding device (column 4, lines 15-65). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine Yang's teaching with the system of Saito. Motivation of the combination would have to be available controls for user selected.

As per independent claims 11 and 21, they are similar in scope to claim 1; therefore, they should be rejected under similar rationale.

As per claim 12, which is dependent on claim 11, it is a similar scope to claim 2; therefore, it should be rejected under similar rationale.

As per claims 13 and 22, which are dependent on claims 11 and 21 respectively, they are similar in scope to claim 3; therefore, they should be rejected under similar rationale.

As per claim 14, which is dependent on claim 13, it is a similar scope to claim 4; therefore, it should be rejected under similar rationale.

As per claim 15, which is dependent on claim 11, it is a similar scope to claim 5; therefore, it should be rejected under similar rationale.

As per claims 16 and 23, which are dependent on claims 11 and 21 respectively, they are similar in scope to claim 6; therefore, they should be rejected under similar rationale.

As per claims 17 and 24, which are dependent on claims 16 and 23 respectively, they are similar in scope to claim 7; therefore, they should be rejected under similar rationale.

As per claims 18 and 25, which are dependent on claims 11 and 21, they are similar in scope to claim 8; therefore, they should be rejected under similar rationale.

As per claims 19 and 26, which are dependent on claims 11 and 21 respectively, they are similar in scope to claim 9; therefore, they should be rejected under similar rationale.

As per claims 20 and 27, which are dependent on claims 19 and 26 respectively, they are similar in scope to claim 10; therefore, they should be rejected under similar rationale.

***Response to Arguments***

Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground of rejection.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mylinh Tran. The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM at 571-272-4141.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo, can be reached at 571-272-4847.

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

571-273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either **Private PAIR** or **Public PAIR**. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BA HUYNH  
PRIMARY EXAMINER